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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,737	12/27/2001	Sammy J. Graham	8350.1653-00	1968

7590 07/12/2006

Finnegan, Henderson, Farabow,
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Washington, DC 20005-3315

EXAMINER

THOMPSON, ANNETTE M

ART UNIT	PAPER NUMBER
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2825

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,737	GRAHAM ET AL.	
	Examiner	Art Unit	
	A. M. Thompson	2825	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 22-24 is/are allowed.
- 6) ☒ Claim(s) 21 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 and 27 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The non-final office action mailed 02/28/2006 has been vacated. The current action restarts prosecution pursuant to Applicants' RCE of 12/09/2005.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 9, 2005 has been entered.
2. Applicants' Amendment to 10/026,737 has been examined. Claims 1-6, 8, 9, 19, 21, and 23-27 are amended. Claims 1-27 are pending.

Claim Objections

3. Claims 19 and 20 are objected to because of the following informalities: Pursuant to claim 20, "the routing design module" lacks sufficient antecedent basis. Pursuant to claim 19, the memory must be computer-readable, so before "memory" insert - -computer-readable- -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claims 21, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph,** as failing to set forth the subject matter which applicants regard as their invention.

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Pursuant to claim 21, Applicants' specification at paragraph 6 discloses that it is "A system" that comprises "a routing design module", not "A tool" as recited. Examiner further notes that Applicants' specification, ¶16, also discloses memory including a routing design module. Applicants must amend the claim language to conform with at least some portion of Applicants' specification, as designated supra.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 21, 25 and 26 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Pursuant to claim 21, it recites "a routing design module" which is disclosed as software in Applicants' specification. Software is not considered a statutory class. Applicants' must amend their claim by reciting the software as embodied in computer-readable media or memory which when executed will perform recited method steps.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Rejection of claim 27

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9. **Claim 27 is rejected under 35 U.S.C. 102(e)** as being anticipated by Pannala et al. (Pannala), U.S. Pub. No. 2003/0079197. Pannala discloses a method and apparatus to generate a wiring harness layout.

10. Pursuant to claim 27, which recites [a] method for designing a routing element that connects a plurality of components in a system (§§ 0004 – 0006)), the method comprising establishing a list of components and connections among the components (§ 21); generating a diagram associated of the system based on the list (§ 18), the diagram illustrating the components and the connections (§§ 19-22), establishing guidelines for designing the routing element (§§ 0022, 0026-29), the guidelines including information reflecting a geometry of the system (§§ 18, 22, 26); and designing the routing element based on the diagram and the guidelines (§§ 0021-0027, see especially § 0027).

Allowable Subject Matter

11. Claims 1-18, 22-24 are allowed.

12. The following is a statement of reasons for the indication of allowable subject matter: In a method of routing an element among a plurality of components in a system, the prior art does not disclose *establishing routing guidelines that include one or more routing recommendations for routing the element in the system.*

Response to Remarks

13. Pannala discloses “establishing guidelines for designing the routing element.” The guidelines constitute predefined symbols (§ 0023) and connection strength information techniques (§§ 0020, 0022).

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Conclusion

14. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m..


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

15. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(571) 273-8300, (for all **OFFICIAL** communications intended for entry)


A. M. THOMPSON
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